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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re PATENT APPLICATION OF

Group Art Unit: 1743

Mitchell D. EGGERS

Examiner: Brian J. Sines

Appln. No.: 10/005,529

Atty Dkt 083022/272516

C# M#

Filed: November 7, 2001

Certificate of Mailing

Title: APPARATUS, SYSTEM, AND METHOD
OF ARCHIVAL AND RETRIEVAL OF SAMPLES

I hereby certify that this correspondence and all marked attachments are being deposited with the United States Postal Service as first class mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on August 13, 2004.

08/16/2004 EFLORER 00000061 502212 10005529

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By: _____

Kim A. Cabello

Kim A. Cabello

Mail Stop Amendment
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

RESPONSE TO RESTRICTION REQUIREMENT UNDER 35 U.S.C. 121

Sir:

Responsive to the Office Action dated June 29, 2004, the time for response having been extended to August 29, 2004, by concurrent petition for extension of time and payment of fee, Applicant provisionally elects, with traverse, Group I, claims 1-76 and 94-101, drawn to a "sample archive system," classified in class 436, subclass 48, for prosecution in the above-entitled application.

The Restriction

As set forth at page 2 of the outstanding Office Action, the Examiner has stated that the claims in Group I (claims 1-76 and 94-101), "drawn to a sample archive system," and the claims in Group II (claims 77-93 and 102-115), "drawn to a method of preparing an archive sample for analysis," are "related as product and process of use." In accordance with the provisions of 37 C.F.R. §1.143, Applicant confirms provisional election of claims 1-76 and 94-101 (*i.e.*, Group I as defined by the Examiner), but respectfully requests reconsideration and withdrawal of the

restriction requirement as set forth below. At this time, Applicant declines to cancel claims 77-93 and 102-115 pending the outcome of the Examiner's reconsideration.

Applicant's Traversal

Initially, Applicant addresses the Examiner's characterization of the relationship between Group I (claims 1-76 and 94-101) and Group II (claims 77-93 and 102-115) at page 2 of the outstanding Office Action. It is difficult to divine exactly what the Examiner understands the claims of Groups I and II encompass given the statements that "[t]he method may employ another different apparatus" and that the "methodology as claimed does not require the *use of a robotics system*" (emphasis supplied). Applicant believes that the Examiner's assertions are beside the point as set forth in more detail below, and additionally believes that the Examiner's comments represent a fundamental misunderstanding which has lead to an improper restriction.

In particular, the pending claims in Group I are directed specifically to various disclosed embodiments including: sample archive systems (claims 1-33), *methods of archiving* samples (claims 34-57), computer readable media (claims 58-62), *methods of preparing an archive sample for analysis* (claims 63-76), and sample node removal systems (claims 94-101). These Group I claims, even those directed to methods, all recite embodiments comprising, among other things, elements related to "a plurality of sample nodes" or "a plurality of discrete sample nodes" (see, e.g., claims 1-33 and 34-62, respectively; the other claims in Group I recite similar language). Pending claims in the Examiner's Group II (claims 77-93 and 102-115) are directed specifically to various disclosed embodiments of *methods of preparing an archive sample for analysis* (as are claims 63-76 which are, interestingly, categorized in Group I by the Examiner). In any event, at least claims 77-93 in Group II recite embodiments comprising, among other things, elements related to "supporting [a] sample on a discrete sample node." Claims 105-107 also include elements related to a "sample node" as described in the present application.

Regarding the "robotics system" identified by the Examiner, Applicant notes that such a system is described, among other places, at least in the text beginning at page 25, line 25, and continuing through page 28, line 6, of the present application (with specific reference to FIG. 3). In the discussion bridging pages 26 and 27, the present application indicates that samples may be handled manually, *i.e.*, without, or with minimal, intervention on the part of automated or robotic mechanisms. Specifically, not only is the "robotics system" clearly not required by the language

of myriad claims in Group I, but in some embodiments (such as those recited in claims 1 and 58, for example), the Examiner's inappropriate importation of a "robotics system" limitation from the specification is not consistent with the written description (*see, e.g.*, page 27, lines 2-4).

Notwithstanding the Examiner's misplaced emphasis on the "robotics system," Applicant submits that pending claims from both Group I and Group II (as described above) include elements related to sample nodes as set forth in detail with specific reference to FIGS. 4A-4C and 5A-5E at pages 28-39 of the present application.

As claims from both Group I and Group II recite similar elements, examination of the claimed sample archive systems (claims 1-33), methods of archiving samples (claims 34-57), computer readable media (claims 58-62), methods of preparing an archive sample for analysis (claims 63-76, 77-93, and 102-115), and sample node removal systems (claims 94-101) cannot be restricted as the Examiner has asserted. A proper and thorough search of the art related to Group I requires a detailed search of the art related to Group II; in that regard, the inclusion of claims 63-76 in Group I is a clear indication that the Examiner has recognized the importance of such a comprehensive search in this case.


Conclusion

Applicant submits that the Examiner cannot perform an adequate search of the art relevant to Group I without also searching art relevant to Group II. Based at least upon the foregoing, Applicant requests reconsideration and withdrawal of the restriction requirement in accordance with 37 C.F.R. §1.143.

Applicant believes that a fee is required at this time. Please apply any charges or credit any overpayments to Deposit Account No. 03-3975.

Respectfully submitted,

Pillsbury Winthrop LLP

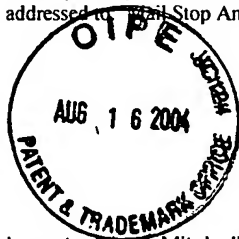


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August 13, 2004

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By: _____

Kim A. Cabello
Kim A. Cabello

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

PATENT APPLICATION

Inventor(s): Mitchell D. Eggers

Appl. No.: 10 | 005,529

Series Code ↑

Serial No. ↑

Filed: November 7, 2001

Mail Stop Non-Fee Amendment

Hon. Commissioner for Patents

PO Box 1450

Alexandria, VA 22313-1450

Group Art Unit 1743

Examiner: Brian J. Sines

Atty. Dkt. 083022 | 272516

C-M

Client Ref

Appl. Title: APPARATUS, SYSTEM, AND METHOD
OF ARCHIVAL AND RETRIEVAL OF
SAMPLES

Sir:

REPLY/AMENDMENT/LETTER

Date: August 13, 2004

This is a reply/amendment/letter in the above-identified application and includes the herewith attachment of same date and subject which is incorporated herein by reference and the signature below is treated as the signature to the attachment in absence of a signature thereto.

FEE REQUIREMENTS FOR CLAIMS AS AMENDED

1. Small Entity claim

A. ☐ NOT madeB. ☐ WithdrawnC. ☐ made herewithD. ☒ made previously

For B & C

See **Required****Separate Paper**

(Pat-256)

	Claims remaining after amendment	Highest number previously paid for	Present Extra	Large/Small Entity	Additional Fee	Fee Code Lg/Sm
2. Total Effective Claims	115	**minus 115	0	x \$18/\$9 =	+ \$0	1202/2202
3. Independent Claims	10	***minus 10	0	x \$86/\$43 =	+ \$0	1201/2201
4. If amendment enters <u>proper</u> multiple dependent claim(s) into this application for <u>first</u> time (leave blank if this is a <u>reissue</u> application)..... add				+ \$290/\$145 =	+ \$0	1203/2203
5. Original due Date: July 29, 2004	<input type="checkbox"/> NONE					
6. Petition is hereby made to extend the original due date to cover the date this response is filed for which the requisite fee is attached	(1 mo)	\$110/\$55 =	+ \$55			1251/2251
	(2 mos)	\$420/\$210 =				1252/2252
	(3 mos)	\$950/\$475 =				1253/2253
	(4 mos)	\$1,480/\$740 =				1254/2254
	(5 mos)	\$2,010/\$1,005 =				1255/2255
7. Enter any previous extension fee paid since above original due date and subtract			- \$0			
8.			Extension Fee	+ \$55		
9. If <u>Terminal Disclaimer</u> attached, add Rule 20(d) official fee			+ \$110/\$55	+ \$0	1814/2814	
10. If IDS attached requires Official Fee under Rule 97 (c), add			+ \$180	+ \$0	1806	
or if Rule 97(d) Request add			+ \$180		1806	
11. After-Final Request Fee per rules 129(a) and 17(r)			+ \$770/385	+ \$0	1809/2809	
12. No. of additional inventions for examination per Rule 129(b)			x \$770/385 ea	+ \$0	1810/2810	
13. Request for Continued Examination (RCE)			+ \$770/385	+ \$0	1801/2801	
14. Petition fee for				+ \$0		
15.			TOTAL FEE =	\$55		

16. *If the entry in this space is less than entry in next space, the "Present Extra" result is "0".

17. **If the "Highest number previously paid for" in this space is less than 20, write "20" in this space.

18. ***If the "Highest number previously paid for" in this space is less than 3, write "3" in this space.

**PLEASE CHARGE
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Our Deposit Account No. 50-2212)

(Our Order No. 083022

272516

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CHARGE STATEMENT: The Commissioner is hereby authorized to charge any fee specifically authorized hereafter, or any missing or insufficient fee(s) filed, or asserted to be filed, or which should have been filed herewith or concerning any paper filed hereafter, and which may be required under Rules 16-18 (missing or insufficiencies only) now or hereafter relative to this application and the resulting Official Document under Rule 20, or credit any overpayment, to our Accounting/Order Nos. shown above, for which purpose a duplicate copy of this sheet is attached.

This CHARGE STATEMENT does not authorize charge of the issue fee until/unless an issue fee transmittal sheet is filed.

Query: Is appeal deadline now? If so, file Notice of Appeals separately.
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NOTE: File this cover sheet in duplicate with PTO receipt (PAT-103A) and attachments